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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,457	12/27/2001	Dennis E. Smith	82987AEK	8364

7590 12/23/2005

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EXAMINER
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AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/033,457

Applicant(s)

SMITH ET AL.

Examiner

Walter B. Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7-19,21,22,24-40,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7-19,21,22,24-40,42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |


**DETAILED ACTION**

1. The Request for Reconsideration filed September 30, 2005 has been received and considered by Examiner.

***REPEATED OBJECTIONS***

2. The objection to the specification made of record in paragraph 4 of the previous Office Action mailed July 1, 2005 has been repeated for the reasons previously made of record.

***REPEATED REJECTIONS***

3. The 35 U.S.C. 112, first paragraph rejection of claims 1, 21 and 42 made of record in paragraph 6 of the previous Office Action mailed July 1, 2005 has been repeated for the reasons previously made of record.
  4. The 35 U.S.C. 112, second paragraph rejection of claims 1, 21 and 42 made of record in paragraph 8 of the previous Office Action mailed July 1, 2005 has been repeated for the reasons previously made of record.
  5. The 35 U.S.C. 102 rejection of claims 1, 2, 5, 7, 9-17, 21, 22, 24-26, 28-36 and 39 made of record in paragraph 9 of the previous Office Action mailed July 1, 2005 has been repeated for the reasons previously made of record.
  6. The 35 U.S.C. 103 rejections of claims 8, 18, 19, 27, 37, 38, 40, 42 and 43 made of record in paragraphs 10-13 of the previous Office Action mailed July 1, 2005 have been repeated for the reasons previously made of record.
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*Response to Arguments*

7. Applicant's arguments presented on pages 1-2 of the Request for Reconsideration regarding the 35 U.S.C. 112, first paragraph rejection of claims 1, 21 and 42 have been fully considered but are not persuasive.

Applicant argues that the passage from the specification that was cited in the previous Office Action ("The invention does not require but permits... pigments...") provides support for the recitation "wherein the microbeads are free of colorant" because the passage teaches that colorants "can be added, but are not required" and therefore that "the absence of such materials is also taught by the passage". The teaching that colorants "can be added, but are not required" does not support the recitation "wherein the microbeads are free of colorant" added in the Amendment filed April 29, 2005 because a teaching that the microbeads may or may not include colorants is not a teaching that the microbeads may not include colorants. The recitation "wherein the microbeads are free of colorant" excludes microbeads including colorants from the scope of the invention, whereas the teaching "[t]he invention does not require but permits... [colorants]..." plainly includes microbeads including colorants within the scope of the invention. Likewise, the teaching of both a presence and absence of colorants is not a teaching of a requirement of an absence of colorants. No statement in the specification as originally filed excludes microbeads including colorants from the scope of the invention.

The fact that the statement in the specification that pigments are "often added" does "not require addition" of pigments likewise does not exclude microbeads including colorants from the scope of the invention. Claims 1, 21 and 42 do not recite that the colorants are not required; the claims recite that the microbeads are free of colorants. The reason for rejection is that no

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embodiments taught in the specification as originally filed require that the microbeads not include colorants, as the claims require without support from the specification as originally filed.

Contrary to Applicant's arguments, a statement that "X can include Y, but does not have to include Y" is plainly not a statement that "X cannot include Y".

8. Applicant's arguments presented on pages 2-3 of the Request for Reconsideration regarding the 35 U.S.C. 112, second paragraph rejection of claims 1, 21 and 42 have been fully considered but are not persuasive.

While Applicant's explanation that CIELAB is not a trademark or tradename on page 2 of the Request for Reconsideration is noted, standards may also change with time. Applicant has not specified the nature of the  $b^*$  value. Furthermore, the specific CIELAB standard is not identified. What specific standard defines the  $b^*$  value, and what is the change a change of (what property is measured at the initial and final time points to determine the change in  $b^*$ ?) Are there units for  $b^*$  values?

Regarding the "on exposure to UV light of 50 Klux for one week" recitation, the scope of the claims cannot be ascertained because it is unclear whether or not the claims require the article to be "expos[ed] to UV light of 50 Klux for one week" for the microbeads to have a change in  $b^*$  value of less than or equal to 0.2: the claims recite that the change in  $b^*$  value is less than or equal to 0.2 "on exposure to UV light of 50 Klux for one week", but this does not require that the article be "expos[ed] to UV light of 50 Klux for one week". The recitation "on exposure" indicates that the microbeads have a change in  $b^*$  value that is less than or equal to 0.2 "on exposure" to the claimed UV light, not that the change in  $b^*$  value is determined from the initial time point at the beginning of the week and the final time point at the end of the week.

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9. Applicant's arguments presented on pages 3-4 of the Request for Reconsideration regarding the art rejections of the claims have been fully considered but are not persuasive. Applicant argues that it was admitted in the Office Action mailed March 29, 2004 that Maier et al. "fail to explicitly teach that the microbeads have [the claimed change in b\* value]" (paragraph 10 of said Office Action), but this rejection was withdrawn in paragraph 3 of the previous Office Action mailed July 1, 2005. Maier et al. anticipates the claims identified in paragraph 9 of the previous Office Action mailed July 1, 2005 for the reasons provided in that paragraph. Applicant's arguments regarding the 35 U.S.C. 103 rejections are all based entirely upon Applicant's arguments regarding the 35 U.S.C. 102 rejection that have been addressed above.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-

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1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

12/21/05

WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

12/21/05